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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,120	02/28/2002	Gerald Steiner	GEST.001A	3606

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EXAMINER

NGUYEN, KIMBERLY D

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 04/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,120

Applicant(s)

STEINER, GERALD

Examiner

Kimberly D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claim Objections

1. Claim 3 is objected to because of the following informalities:

The phrase "capable of" is vague and indefinite. It has been held that the recitation that an element is "**capable of**" or "**adapted to**" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

- Claim 3, line 1: "adapted to be" should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Kadaba et al. (US 6,285,916; hereinafter "Kadaba").

Kadaba teaches a package for mailing items from a merchant/sender to a customer/recipient, the package/item comprising:

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at least one surface, the surface having a barcode 30 thereon; wherein the barcode identifies the customer i.e. the identity of the intended recipient (fig. 3: col. 5, line 56 through col. 6, line 9).

4. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Dejaeger et al. (US 6,456,981; hereinafter "Dejaeger").

Dejaeger teaches a method of advertising, the method comprising the steps of:

retrieving retail information included the user's profile associated with a user's previous purchase of the user, which serves as accumulating information about orders placed by a customer (fig. 1; col. 5, line 58 through col. 6, line 43);

analyzing the information;

predicting, based on the information, what type of items the customer is likely to purchase in the future; and

providing the customer with advertising directed toward those items (col. 6, line 65 through col. 7, line 67).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadaba in view of Diedrich (US 5,893,512) and Nozaki et al. (US 6,349,194; hereinafter "Nozaki"). The teachings of Kadaba have been discussed above.

Although, Kadaba teaches a "scan history" containing the package/parcel information such as received by, sent by, or in transit to a particular person (col. 8, lines 12-15).

Kadaba fails to teach or fairly suggests the barcode includes a complete order and return history for the customer.

Diedrich teaches merchandise return tracking indicia 62, 63, which can provide a return address, customer information, etc., wherein the merchandise return tracking indicia 62, 63 is in a machine readable form, such as a barcode (fig. 1; abstract; col. 5, lines 13-18).

Nozaki teaches a barcode, which includes an order history of a customer (col. 6, lines 24-46).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the barcode containing merchandise return information as taught by Diedrich and the barcode containing order history as taught by Nozaki to the teachings of Kadaba in order to provide a more informative system to the customer/merchant. Such modification would provide a better tracking about the merchandise or customer for business education/purposes i.e. profiling a merchandise having quick sale or a customer having interesting in a particular merchant; therefore, it would have been an obvious extension as taught by Kadaba.

7. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markman (US 5,962,834) in view of Hauser et al. (US 6,536,659; hereinafter "Hauser").

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Markman teaches a method of tracking an order history of a customer, the method comprising the steps of:

providing a package including a barcode that identifies the customer (i.e. shipping address for the customer) (col. 2, lines 7-22);

scanning the barcode to identify the customer (col. 2, lines 7-22);

updating the customer's order history (figs. 1-2; col. 5, line 62 through col. 6, line 40; col. 8, line 63 through col. 9, line 18).

Markman fails to teach or fairly suggests the return history of the customer.

Hauser teaches a method of tracking a return of a customer, the method comprising:

receiving the package from the customer, the package containing returned items;

inputting the returned items into an inventory database; and

updating the customer's return history (figs. 1-6; abstract; col. 2, lines 9-38; col. 3, line 43 through col. 6, line 17).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the tracking returned merchandise system as taught by Hauser to the teachings Markman in order to provide a method and system for handling/tracking a returned merchandise from a customer.

8. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dejaeger in view of Hauser. The teachings of Dejaeger have been discussed above.

Dejaeger fails to teach or fairly suggests a package including a barcode that identifies the customer.

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Hauser teaches a package including a barcode that identifies the customer (abstract: col. 8, lines 23-54).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a package including a barcode that identifies the customer as taught by Hauser to the teachings of Dejaeger in order to conveniently identify customer's information directly from a barcode which is attached on the package.

9. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dejaeger in view of Rando et al. (US 5,128,520; hereinafter "Rando"). The teachings of Dejaeger have been discussed above.

Dejaeger fails to teach or fairly suggests the advertising is provided to the customer in a second package that includes the customer's barcode.

Rando teaches a coupon 24 having a barcode thereon, which is mailed to the customer, from the direct mail advertising (fig. 1; col. 1, lines 13-27; col. 5, lines 33-55).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the advertising package including a barcode as taught by Rando to the teachings of Dejaeger in order to conveniently identify customer's information directly from a barcode which is attached on the package.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Christ (US 6,529,798) teaches process for handling articles in the mail order business. Beller et al. (US 5,602,377) teaches barcode dataform scanning and labeling apparatus and method.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 703-305-1798. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-1341 for regular communications and 703-305-1341 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-8792.

KDN
April 4, 2003


KARL D. FRECH
PRIMARY EXAMINER